

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

5497-015

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on May 20, 2010

Signature /Karen S. Schuller/Typed or printed name Karen S. Schuller

Application Number

10/789485

Filed

2004-02-27

First Named Inventor

Thilo Stolze

Art Unit

2811

Examiner

Andrew Owens Arena

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/Mark R. Bilak Reg. No. 47423/☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Mark R. Bilak

Typed or printed name

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attorney or agent of record.

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

May 20, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

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In re Application of Stolze

Serial No.: 10/789,485

Filed: February 27, 2004

For: **Power Semiconductor Module**

Docket No: 5497-015

PATENT PENDING

Examiner: Mr. Andrew Owens Arena

Group Art Unit: 2811

Confirmation No.: 7994

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ARGUMENTS SUBMITTED WITH PRE-APPEAL BRIEF REQUEST FOR REVIEW

The claim rejections are based on clear error at least for the reasons given below, and therefore all claim rejections must be withdrawn. First, the pending independent claims recite the connecting elements are formed by recesses in the module housing and the module housing encloses the substrate regions. In support of the claim rejections, it is argued at lines 9-10 on p. 2 of the Advisory Action that the entire assembly shown in Figure 4 of the Ali reference is akin to the claimed housing, including socket 20 and the void/open region shown in the middle part of the socket 20.

This finding directly contradicts the express teachings of the Ali reference. Neither the socket nor the void/open region in the middle of the socket 20 is formed by a recess in a housing as claimed. In direct contrast, the socket 20 with the open space/void is contained within Ali's housing. In support of Applicants' position, the Ali reference explicitly defines element 11 in Figure 4 as the housing of a system 10 such as a computer (*c.f.* col. 2, lines 8-16

of Ali). The Ali reference further explicitly states that a support structure 12 such as a main circuit board or some other support structure includes the socket 20, and the socket 20 has ports for coupling to electronic devices 14 and 16 (*c.f.* col. 2, lines 8-11 of Ali). The support structure 12 with socket 20 and the electronic devices 14 and 16 are "contained within the housing 11" of the system 10 according to the express teachings of the Ali reference (*c.f.* col. 2, lines 11-13 of Ali) (emphasis added). Therefore, the entire assembly shown in Figure 4 of the Ali reference is not a housing as argued in the Advisory Action. Instead, only element 11 in Figure 4 of the Ali reference is a housing. To find otherwise ignores the express teachings of the Ali reference. The claim rejections must be withdrawn because neither the socket 20 nor the void/open region in the middle of the socket 20 is formed by a recess in Ali's housing 11 as claimed.

In addition, each pending independent claim recites that the recesses extend from an exterior of the housing. The term "exterior" is used in the pending claims as a noun and not and adjective, and is properly construed to mean "the outer surface or part; outside" as proffered in the office action reply filed on 19 April 2010. The Examiner does not dispute this construction (*c.f.* line 12 on p. 2 of the Advisory Action). However, it is argued at lines 19-20 on p. 2 of the Advisory Action "for extended bodies with many pieces contained in the interior, the idea of extending from an exterior is properly and reasonably interpreted to include items on the interior" (emphasis added).

The recess extending from the exterior of the housing as claimed cannot include "items on the interior" as argued by the Examiner in the Advisory Action. Such a construction strips the noun "exterior" of any appreciable meaning. Items on the interior of a housing do not include the outer surface or outside of the housing. Moreover, the Examiner gives an example of a residential home with a dividing wall extending into a room from an exterior wall in further

support of the Patent Office's position. However, this example uses the word "exterior" as an adjective to describe the wall, not a noun as used in the pending claims.

Socket 20 of Ali's system 10 does not extend from the exterior of housing 11 as claimed. Instead, the socket 20 abuts the interior surface of circuit board 12 and extends downward to lower plate 66 as shown in Figures 2 and 4 of Ali. No reasonable construction of the term "exterior" can include the interior surface of the circuit board 12 to which the sockets 20 are attached. To find otherwise would directly contradict the plain and ordinary meaning of the noun "exterior." Accordingly, all claim rejections are in clear error and must be withdrawn because the alleged connecting elements in the Ali reference (sockets 20) extend from the interior of the circuit board 12, not the exterior of housing 11 as claimed.

Also, the Examiner misinterprets Figure 3 of the instant application. In referring to Figure 3 of the instant application, the Examiner states that recess 130 extends from top side 140 of housing 120 without the recess itself being outside (*c.f.* the second last sentence on p. 2 of the Advisory Action). Figure 3 of the instant application shows a second embodiment of the claimed invention where recesses 130 and 131 formed in housing 120 extend from the exterior module underside 125. Thus, the embodiment shown in Figure 3 of the instant application is consistent with and fully supports Applicants' position that the claimed recesses formed in the housing extend from an exterior, *i.e.*, outer surface or outside of the housing. Applicants note that Figure 1 of the instant application shows a first embodiment of the claimed invention where recesses 35 and 36 formed in housing 20 extend from the exterior module topside. In both embodiments, the recesses formed in the housing extend from an exterior, *i.e.*, outer surface or outside of the housing as claimed. The claim rejections are based on further error and therefore must be withdrawn for this yet additional reason.

Respectfully submitted,
COATS & BENNETT, P.L.L.C.

A handwritten signature in black ink, appearing to read "Mark R. Bilak". The signature is written in a cursive, flowing style. Below the signature is a horizontal line.

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